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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/972,403
Filing Date: October 05, 2001
Appellant(s): ALBAZZ ET AL.

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Scott D. Paul
For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed **2 August 2010** appealing from the Office

action mailed **2 March 2010**.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

a.) Claims 9-11, 13-19, 21-24, 33-35 and 37-40 are rejected under 35 USC Section 103(a) as being unpatentable over **Conklin et al. (U.S. 6,338,050)** (Hereinafter "**Conklin**") in view of **Shirley et al. (US 5/692,206)** (hereinafter "**Shirley**")

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Conklin et al.	(U.S. 6,338,050)	01/2002
Shirley et al.	(US 5/692,206)	11/1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 9-11, 13-19, 21-24, 33-35 and 37-40** are rejected under 35 U.S.C. 103(a)

as being unpatentable over **Conklin et al. (U.S. 6,338,050)** (Hereinafter referred to as

Conklin) in view of **Shirley et al. (US 5/692,206)** (hereinafter "**Shirley**") .

1.   With respect to **Claims 9, 17, and 33:**

Conklin discloses:

storing the contract terms and conditions (Conklin: col. 21 – relational

structuring of database; Figs. 1h; 1I; 11a-1 and 11a-2 – terms to be entered in

the contract are chosen; col.23 – storing of negotiations and results data;

detailed rules for ordering),

receiving information (Conklin; Col. 23, lines 15-67 – desktop computer

and Internet used), and

communicating a user interface to a contracting wherein the user interface

displays selected information based on terms and conditions in the contract

(Conklin; Figs. 1h; 1I; 11a-1 and 11a-2 – terms to be entered in the contract are

chosen via Internet presentation, Col. 23, lines 15-67 – desktop computer and

Internet used; Fig. 16 - types of terms chosen)

the contract is generated by:

storing at least one compilation of business rules comprising a plurality of

rules available to be selected for inclusion in the contract, storing at least one

terms and conditions set containing parameters corresponding to selected rules

from the compilation of business rules, generating links between the compilation
of business rules and the terms and conditions set to generate specific terms and
conditions to be embodied in the contract. (Conklin: Fig. 1j – rules built based on
community; col. 21 – relational structuring of database; col.23 – storing of
negotiations and results data; detailed rules for ordering);

and interlocking the compilation of business rules, the terms and
conditions set and the links to lock the contract (Conklin: Fig. 1j – rules built
based on community; cols. 19 and 21 and col. 22, lines 1-40 – authoring process
integrated with databases; relational structuring of databases; "databases 225
created according to the present invention use a combination of record, filed,
relational names and delimiters to interrelate the elements within; Data is kept
secure with firewalls and SSL encryptions; col. 20, lines 45-65 – "the present
invention protects the documents with separate user names, passwords and
access levels for each inquirer"; col. 21, "Unique id's feature is used to insure the
proper data is found and transmitted. That is, the present invention associates
unique identifiers (id's) with each sponsor, participant, and type of data or
transaction. Since database functions are integrated directly with the other
functions of the invention, faster processing and updating of the database is
enabled."; col. 24, lines 15-60 - final document is noted as complete);

Conklin does not teach, however Shirley teaches referencing the terms
and conditions of the contract to process the information and generate user
interfaces in response (Shirley: Figs. 11a and 11b; col. 6, lines 20-60; col. 8-col.

9, line 30 – provisions are selected by authoring unit and used by user to complete document and use in Microsoft Word)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Conkling and Shirley. Both references discuss the steps involve with the generation of a contract. The references of the terms and conditions of a contract are necessary for future interpretation in case of a dispute.

2.   With respect to **Claims 11, 19 and 35:**

Conklin discloses in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list (Conklin col. 19, lines 57-60, "Buyer processes shown in FIG. 1g include search and evaluate processes, which enable a prospective buyer to find companies and their products in the community and investigate their prices, terms and service offerings."; col. 20, lines 1-50 – catalog and price list; web server software used).

3.   With respect to **Claims 13, 21, 37:**

Conklin discloses storing at least one product list filter for generating a list of a specified subset of products from a master list of products, and generating links between the product list filter, the terms and conditions set and the master list of products (Conklin col. 21, "Unique id's feature is used to insure the proper data is found and transmitted. That is, the present invention associates unique identifiers (id's) with each sponsor, participant, and type of data or transaction. Since database functions are integrated directly with the other functions of the invention, faster processing and

updating of the database is enabled."; relational names and delimiters to interrelate the elements within).

The data in which the product list is non-functional descriptive data.

4.   With respect to **Claims 14, 22 and 38:**

Conklin discloses the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products (Conklin Fig 1g, item 70, "Search & Evaluate").

The data in which the product list is non-functional descriptive data.

5.   With respect to **Claims 15, 23 and 39:**

Conklin discloses the contract comprises dynamic elements which can be unilaterally altered by a contracting party (Conklin col. 23, lines 37-53, "participant proposing terms to another participant on an initiating terminal (or desktop computer or workstation, etc.) over the Internet through multivariate negotiations engine system, thereby creating a communications path which is ultimately directed by multivariate negotiations engine system over the Internet to the destination terminal at which the selected other participant is active.").

The data in which the contract contains is non-functional descriptive data.

6.   With respect to **Claims 16 and 40:**

Conklin discloses the product list filter is a dynamic element (Conklin col. 14, lines 1-29, "…allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms…").

The data in which the product list is non-functional descriptive data.

7.   With respect to **Claims 10, 18, and 35:**

Conklin discloses the user interface displays selected information based on terms and conditions in the contract (Conklin col. 14, lines 1-29, "…allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms…").

(10) Response to Argument

A. The 35 USC 101 and 35 USC 112 paragraph 2 rejections are withdrawn from consideration.

B. The 35 USC 103(a) rejection was applied using Rationale A

Applicant argues inaccurately that rationale G or the teaching, suggestion and motivation test was applied in the 35 USC 103 analysis. The KSR Intl. Co. v. Teleflex Inc., 82 USPQ2d 1385 (2007) decision notes that other rationales besides the teaching, suggestion and motivation test to use in determining whether a combination of references is obvious. According to MPEP Section 2141, "If the search of the prior art and the resolution of the Graham factual inquiries reveal that an obviousness rejection may be made using the familiar teaching-suggestion-motivation (TSM) rationale, then such a rejection should be made. Although the Supreme Court in KSR cautioned against an overly rigid application of TSM, it also recognized that TSM was one of a number of valid rationales that could be used to determine obviousness." Accordingly, MPEP Section 2141 notes the Rationales A to G to be applied to support a conclusion of obviousness.

As a result, Examiner utilized the rationale A "Combining prior art elements according to known methods to yield predictable results." The combination of the two references does present a predictable result.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Conklin and Shirley references. Both references teach the process involved with creating a legally binding agreement. The Conkling reference teaches the negotiation process between buyers and sellers. The system allows them to negotiate terms like payment options. While Figure 1a of Conklin teaches that the system uses computers. Shirley teaches that the provisions of the agreement during negotiations are chosen by and stored in the authoring unit.

Rationale A was appropriately applied.

C. Applicant's argument regarding the 35 USC 103(a) rejection is inadequate because Applicant never addresses the Shirley reference in the arguments and therefore the finding of fact is not disputed

1.   Applicant never argued the Shirley reference in the brief and as a result the reference is not in dispute. While the Shirley reference was acknowledged this reference was not discussed in the arguments and therefore the finding of fact attributed to this reference is not in dispute.

2.   Furthermore, the 35 USC 103(a) rejection combining both the Conklin and the Shirley references was adequately applied. Applicant argues inaccurately that rationale G or the teaching, suggestion and motivation test was applied in the 35 USC

103 analysis.   The KSR Intl. Co. v. Teleflex Inc., 82 USPQ2d 1385 (2007) decision

notes that other rationales besides the teaching, suggestion and motivation test to use

in determining whether a combination of references is obvious.   According to MPEP

Section 2141, "If the search of the prior art and the resolution of the Graham factual

inquiries reveal that an obviousness rejection may be made using the familiar teaching-

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the Supreme Court in KSR cautioned against an overly rigid application of TSM, it also

recognized that TSM was one of a number of valid rationales that could be used to

determine obviousness." Accordingly, MPEP Section 2141 notes the Rationales A to G

to be applied to support a conclusion of obviousness.

As a result, Examiner utilized the rationale A "Combining prior art elements

according to known methods to yield predictable results." The combination of the two

references does present a predictable result.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the Conklin and Shirley references. Both references teach the

process involved with creating a legally binding agreement. The Conkling reference

teaches the negotiation process between buyers and sellers.   The system allows them

to negotiate terms like payment options. While Figure 1a of Conklin teaches that the

system uses computers. Shirley teaches that the provisions of the agreement during

negotiations are chosen by and stored in the authoring unit.

D. The Conklin reference was correctly used to reject the claimed limitations

1.   Business rules are not specifically defined in the specification

For the most part the specification is vague as to what constitutes a business rule.

For example, the specification notes on page 6 that "a buyer comprises a Business Rules Book (BRB) … containing a set of rules from which specific rules may be selected for inclusion in the contract." Page 9 states "the contract is generated by storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract". Furthermore, page 14 states "BRB offers sufficient flexibility for the administrator organization to amend business rules and introduce new business rules in response to market changes and buyer demands".

Only on page 16 are slightly more details given in that for split orders policy, "splitting rules" are noted but not details and for multi-currency transactions "rounding-off rules" are also noted without details.   Unlike Applicant's arguments these rules show that the type of "rules" discussed in the specification are more aligned with terms and conditions of the contract.

Applicant in the arguments attempts rather after-the-fact to present more business rules detail that was not presented in the specification by noting what the Conklin reference does not disclose. Applicant argues on page 15, "'the detailed rules for ordering' are not available to be selected for inclusion in the contract." However, in

the specification the rules noted are merely mentioned and whether or not they are just used in the negotiations and/or the contract is not specified. Therefore, there remains no detail in the specification or the arguments to show that business rules could not also perform as terms and conditions.

2.   Applicant argues that the negotiations and results data stored in the Conklin system should be the same data discussed in the claims and presented on page 15. However the list presented on claim 15 cannot be substituted at the point in the prosecutorial process for claimed limitations. The claims have not been amended to teach the 5 points noted. Furthermore, Applicant's independent claim 9, for example to "generating links between the compilation of business rules" and not just "a compilation of business rules".

The term "interlocking" is also addressed in Applicant's arguments. The specification on page 26 states in one of the two places interlocking is discussed "When final revisions of all contract elements are approved by negotiating parties, all elements are interlocked by the seller contract administration staff to prevent further changes to the contract." The Conklin reference teaches the negotiation process and in column 24 notes that the final contract is noted as complete. When the agreement in finalized the terms are locked. Any other special notation of interlocking is not discussed in the specification and therefore not presented in the claims but argued can only be considered new matter. The Conklin reference is adequate because it teaches the limitations presented and as such was correctly used to reject the current application.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Heidi Riviere/

Examiner, Art Unit 3689

Conferees:

Janice Mooneyham

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